

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed October 25, 2004. At the time of the Office Action, Claims 1-32 were pending in this Application. Claims 1-32 were rejected. Claims 1-32 have been amended to further define various features of Applicants' invention. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 112

Claims 1-32 were rejected by the Examiner under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Applicants amend Claims 1-32 to overcome these rejections and respectfully request full allowance of Claims 1-32 as amended.

Claims 1-32 were rejected by the Examiner under 35 U.S.C. §112, second paragraph, as being indefinite and failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants amend Claims 1-32 to overcome these rejections and respectfully request full allowance of Claims 1-32 as amended.

Rejections under 35 U.S.C. § 102

Claims 1-7, 9-15, 17-23, 25-29, and 31-32 were rejected by the Examiner under 35 U.S.C. §102(e) as being anticipated by U.S. Patent 6,755,353 issued to Jack Lorraine et al. ("Lorraine et al."). Applicant respectfully traverses and submits Lorraine et al. do not teach "a compensation member for filling a hollow space between a cylinder and a piston plate, wherein said compensation member has a thermal expansion coefficient higher than the thermal expansion coefficient of the piezoelectric stack." Thus, Applicants request withdrawal of the rejection and favorable action.

Rejections under 35 U.S.C. §103

Claims 8, 16, 24, and 30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lorraine et al. Applicant respectfully traverses and submits that Claims 8 and 16 dependent on Claim 1, Claims 24 and 30 dependent on Claim 17, for the reason stated above are patentably distinct of the art cited.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Here, all elements, as noted above, are not taught by the art combination. The art combined does not teach the "compensation member" as claimed. Favorable action is requested.

CONCLUSION

Applicants have now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of the claims as amended.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees to Deposit Account No. 50-2148 of Baker Botts L.L.P. in order to effectuate filing.

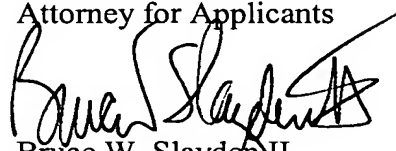
ATTORNEY DOCKET
071308.0445

PATENT APPLICATION
10/682,042

9

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2606.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorney for Applicants



Bruce W. Slayden II
Reg. No. 33,790

SEND CORRESPONDENCE TO:
BAKER BOTTS L.L.P.
CUSTOMER ACCOUNT NO. 31625
512.322.2606
512.322.8306 (fax)

Date: 1/25/2005